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Paper No. 11

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FEB 03 2003

In re Application of : **OFFICE OF PETITIONS**
Svensson et al. :
Application No. 09/758,631 : **ON PETITION**
Filed: January 10, 2002 :
Attorney Docket No. 061450-0027 :
:

This is a decision on the petition under 37 CFR 1.183 filed January 10, 2001, on the petition under 37 CFR 1.137(b) filed August 23, 2001, and on the petition under 37 CFR 1.181 filed January 2, 2002.

The petition under 37 CFR 1.183 is **dismissed as moot**.

The petition under 37 CFR 1.137(b) is **dismissed as moot**.

The petition under 37 CFR 1.181 is **granted in part and dismissed in part**.

Any request for reconsideration must be submitted within TWO (2) MONTHS from the mail date of this decision. No further petition fee is required for the request. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.181." This is **not** final agency action within the meaning of 5 U.S.C. § 704.

The application was filed on January 10, 2002, along with a petition under 37 CFR 1.183 requesting waiver of portions of the PBG-Final Rule for new reissue applications. Such waiver was necessary because the application failed to comply with the new rule in so far as the application was filed in single column format rather than double.

On February 5, 2001, a Notice to File Missing Parts was mailed to applicant stating, "Assignees statement under 37 CFR 3.73(b) establishing ownership of the patent is missing." The Notice stated that a 37 CFR 3.73(b) statement and \$130 surcharge must be submitted. The Notice stated that the "reissue specification has not been provided in double-column format as is required by 37 CFR 1.173(a)(1)." The Notice set a period for reply of two (2) months from the mail date of the Notice and stated that extensions of time could be obtained.

On August 23, 2001, petitioner filed a statement under 37 CFR 3.73(b), the \$130 surcharge, and a specification in double-column format. The papers contain authorization for the Office to charge necessary fees to deposit account no. 16-2230. Petitioner also filed a petition under 37 CFR 1.137(b) on August 23, 2001.

With the filing of the papers on August 23, 2001, relief under 37 CFR 1.183 appears to no longer be necessary. Therefore, the petition under 37 CFR 1.183 is dismissed as moot. A petition fee of \$130 has not been charged for the petition under 37 CFR 1.183.

As to the petition under 37 CFR 1.137(b), the petition is dismissed as moot because the

application is not abandoned. Office records indicate the \$1,240 fee was previously refunded. The Notice of Missing Parts allowed petitioner to buy an extension of time up to 5 months. Therefore, with the maximum extension of time, petitioner had until September 5, 2001, to file a response to the Notice of Missing Parts. Deposit account no. 16-2230 listed on the August 23, 2001 papers, will be charged for a 5 month extension of time.

For the above reasons, the petition under 37 CFR 1.181 is granted to the extent the petition requests a refund of \$1,280. However, the petition is dismissed to the extent that petitioner requests a refund of \$130 since the fee was due when the fee was submitted on August 23, 2001. MPEP 1410 states,

[W]here an application is filed without . . . the consent of all assignees, if the application otherwise complies with 37 CFR 1.53(b) and the reissue rules, the Office of Initial Patent Examination (OIPE) will . . . accord send out a notice of missing parts setting a period of time for filing the missing part and for payment of any surcharge required under 37 CFR 1.53(f) and 1.16(e). If the reissue oath or declaration is filed but the assignee consent is lacking, the surcharge is required because, until the consent is filed, the reissue oath or declaration is defective, since it is not apparent that the signatures thereon are proper absent an indication that the assignees have consented to the filing.

Office records indicate the \$130 fee was incorrectly refunded on April 11, 2002. Therefore, the \$130 will be charged to deposit account no. 16-2230.

Petitioner may wish to note that, had the papers filed on August 23, 2001, not been timely filed, the application would have become abandoned despite the Office's later steps to withdraw the Notice. Abandonment is not based on the correctness, in whole or in part, of an Office action. If an applicant fails to respond to a restriction requirement which the examiner later determines is untenable as drafted, the application is abandoned. If an Office action is mailed rejecting claims based on anticipation over a reference that was facially not available as prior art against the application, an applicant must still respond to the Office action in order to avoid abandonment.

The Office of Petitions wishes to note that the Office of Petitions is unclear why the Office of Initial Patent Examination mailed a paper withdrawing the Notice of Missing Parts and stating that the Notice was erroneous. However, as discussed previously, the Office of Petitions need not address the correctness of the original Notice since such an issue would not affect the decisions on the petitions which have been filed.

The file is now being forwarded to Technology Center 2800 for further prosecution using the new specification, in double-column format, filed August 23, 2001.

Telephone inquiries should be directed to Petitions Attorney Steven Brantley at (703) 306-5683.



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Office of Petitions